

REMARKS

With entry of this Amendment, claims 32-37 are pending in this application. Claims 32, 34, and 36 are amended to clarify the subject matter recited therein and to correct typographical errors. Claims 38-43 are canceled without prejudice to or disclaimer of the subject matter recited therein. No new matter has been added.

Applicants acknowledge the withdrawal of the rejection of claims 32-43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Malek et al. (U.S. Patent No. 5,130,238) in view of Kenten et al. (U.S. Patent No. 6,174,709). Prosecution is reopened in view of Applicants' Appeal Brief filed on January 23, 2004. Office Action, page 2.

The Amended Claims Are Definite

Claims 32-43 are newly rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action, page 2.

According to the Examiner, claims 32-43 are indefinite for the recitation of "the reaction mixture" without a proper antecedent basis in claims 32(b) and 38(b). *Id.* Claim 32 is amended to recite a first and a second composition. Part (b) of claim 32 is amended to recite "said first composition," which has antecedent basis in part (a) of the claim. Claims 38-43 are canceled without prejudice to or disclaimer of the subject matter recited therein, rendering their rejection moot.

The Examiner also asserts that claims 32-43 are indefinite because they are drawn to a method for detecting a specific nucleic acid, but recite a final step of detecting a solid phase-bound complex "using said electrochemiluminescent species." *Id.*, pages 2-3. Without acquiescing in the rejection, Applicants amend claim 32 to recite that "said specific nucleic acid sequence" is detected "by measuring

electrochemiluminescence from said solid phase-bound hybridization complex." It would be clear to one skilled in the art that "said solid phase-bound hybridization complex" comprises "an amplified nucleic acid sequence" amplified from the "specific nucleic acid sequence" and that the electrochemiluminescence would be proportional to the amount of the amplified sequence in the solid phase-bound hybridization complex and, therefore, indicate the presence of the specific nucleic acid sequence in the sample. Claims 38-43 are canceled without prejudice to or disclaimer of the subject matter recited therein, rendering their rejection moot.

The Examiner contends that claims 34 and 40 are indefinite for their recitation of "the binding species/binding pair" because this phrase allegedly lacks antecedent basis. *Id.*, page 3. Without acquiescing in the rejection, Applicants amend claim 34 to recite "wherein the binding species and the binding partner are." The terms "binding species" and "binding partner" find antecedent basis in claim 32. Claim 40 is canceled without prejudice to or disclaimer of the subject matter recited therein, rendering this rejection moot.

According to the Examiner, claims 36 and 42 are indefinite for their recitation of "RNA first template," which allegedly lacks antecedent basis. *Id.* Without acquiescing in the rejection, Applicants amend claim 36 to recite "said RNA template," which finds antecedent in subpart (i) of each claim. Claim 42 is canceled without prejudice to or disclaimer of the subject matter recited therein, rendering this rejection moot.

The Examiner contends that claims 38-43 are indefinite for the recitation of "the sample" in subpart (a) of claim 38. *Id.* The Examiner also rejects claims 38-43 as allegedly indefinite for the recitation of "wherein, optionally, said first primer, second

primer or at least one of said nucleotides is labeled with the electrochemiluminescent species and said detection probe is omitted, and, optionally, said first primer, second primer or at least a portion of said nucleotides is labeled with the binding species and said capture-probe is omitted." *Id.*, pages 3-4. Claims 38-43 are canceled without prejudice to or disclaimer of the subject matter recited therein, rendering these rejections moot.

Applicants respectfully request the reconsideration and withdrawal of the rejections of claims 32-37 under 35 U.S.C. § 112, second paragraph.

Obviousness-type Double Patenting

Claims 32-43 are also newly rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-10 of U.S. Patent No. 6,048,687. Office Action, page 5. Solely to advance prosecution and without acquiescing in the rejection, Applicants file herewith a Terminal Disclaimer.

For this reason, Applicants request the withdrawal of the rejection of claims 32-37 for obviousness-type double patenting.

The Pending Claims Are Not Obvious over Malek and Kenten

Claims 38-43 are newly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Malek et al. (U.S. Patent No. 5,130,238, "Malek") in view of Kenten et al. (Clin. Chem., 37: 1629-1632, 1991, "Kenten"). *Id.*, page 6. Solely to advance prosecution and without acquiescing in the rejection, Applicants cancel claims 38-43 without prejudice to or disclaimer of the subject matter recited therein, rendering this rejection moot.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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